

**REMARKS**

By this amendment, Applicants amend claims 1, 10, and 24-27, and add new claims 28-31. Claims 1-10 and 16-31 remain pending.

In the August 9, 2007, Final Office Action<sup>1</sup>, the Examiner rejected claims 1-10 and 16-27 under 35 U.S.C § 103(a) as being unpatentable over U.S. Patent No. 6,058,413 to Flores ("*Flores*") in view of U.S. Published Patent Application No. 2005/0177507 to Bandyach et al. ("*Bandyach*"). The Examiner maintained these rejections in the December 11, 2007 Advisory Action.

Applicants respectfully traverse the rejection of claims 1-10 and 16-27 under 35 U.S.C § 103(a) as being unpatentable over *Flores* in view of *Bandyach*. No *prima facie* case of obviousness has been established.

"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements." M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art." M.P.E.P. § 2143.01(III) (emphasis in original). "In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the

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<sup>1</sup> As Applicants' remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicants' silence as to certain assertions or requirements applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references, etc.) is not a concession by Applicants that such assertions are accurate or such requirements have been met, and Applicants reserve the right to analyze and dispute such in the future.

claimed invention as a whole would have been obvious. M.P.E.P. § 2141.02(I)  
(emphases in original).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966). . . . The factual inquiries . . . [include] [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Here, a *prima facie* case of obviousness has not been established because the Examiner has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Accordingly, the Examiner has failed to clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art.

Independent claim 1 recites “a method for automatically filing documents relating to business transactions using a computer system,” including, among other things,

transforming the at least one input data record into an output data record, wherein the output data record includes a first data area formatted for compatibility with a first business application, and a second data area formatted for compatibility with a second business application.

On page 3 of the Final Office Action, the Examiner does not allege that *Flores* discloses the claimed “transforming,” and instead alleges that *Bandyach* discloses this feature. However, this is not correct.

*Bandyach* discloses a transaction between a buyer and seller (alleged “business transaction”), among a plurality of transactions among a plurality of buyers and sellers.

*Bandyach*, ¶ [0067] *et seq.* *Bandyach* discloses using interactive platform 15 to store and organize documents from both the buyer and the seller that relate to the transaction, as a collaborative data set. *Id.* These documents within the collaborative data set are identified as being related to the particular transaction, and tagged with an identifier specific to the transaction (MatchID). *Id.* at ¶ [0126]. *Bandyach* discloses that the buyer and seller may retrieve data from the collaborative data set that corresponds to the particular transaction by referring to the MatchID. *Id.* at ¶ [0121]. *Bandyach* also appears to disclose converting the data to an application specific format for either the buyer or the seller upon retrieval of the data by either the buyer or the seller. See Examiner's allegations in the Advisory Action.

In the Advisory Action, the Examiner alleges that *Bandyach's* buyer and seller correspond to the claimed "first and second business applications," and that *Bandyach's* collaborative data set corresponds to the claimed "output data record." The Examiner further states that *Bandyach's* purported ability to convert specific transaction data in the collaborative data set to a format specific to the buyer (or seller) corresponds to the claimed "first data area formatted for compatibility with a first business application, and a second data area formatted for compatibility with a second business application." Advisory Action. However, this is not correct, at least because the buyer-formatted data or seller-formatted data is not part of the collaborative data set (alleged "output record"). Instead, the buyer-formatted data and seller-formatted data are derived from the collaborative data set, and are separate data, which are not located in the same record. Accordingly, *Bandyach* cannot teach or suggest that "the output data record includes a first data area formatted for compatibility with a first business application, and a second

data area formatted for compatibility with a second business application,” as recited in claim 1.

In view of the failure of the prior art to teach or suggest a combination including the elements of claim 1 discussed above, the Office Action has failed to properly determine the scope and content of the prior art and to properly ascertain the differences between the prior art and the claimed invention. Thus, the Office Action has failed to clearly articulate a reason why the claims would have been obvious to one of ordinary skill, in view of the prior art. Accordingly, no *prima facie* case of obviousness has been established, and the Examiner should withdraw the rejection of independent claim 1 under 35 U.S.C § 103(a).

Independent claims 10, 24, and 31 while differing in scope from claim 1, comprise similar recitations as claim 1. Accordingly, the Examiner should withdraw the rejection of claims 10 and 24 at least due to the reasons discussed previously.

Claims 2-9, 16-23, and 25-27 depend from one of independent claims 1, 10, and 24. Accordingly, the Examiner should withdraw the rejection of claims 2-9, 16-23, and 25-27 at least due to their dependence.

### **CONCLUSION**



In view of the foregoing, Applicants submit that the pending claims are neither anticipated nor rendered obvious in view of the references cited against this application. Applicants therefore request the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge  
any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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